



PATENT APPLICATION

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of

Docket No: Q63846

Ferdinand GRÖGL, et al.

Appln. No.: 09/915,528

Group Art Unit: 2831

Confirmation No.: 7040

Examiner: Chau N. NGUYEN

Filed: July 27, 2001

For: CABLE WITH AT LEAST ONE TRANSMISSION ELEMENT

REPLY BRIEF PURSUANT TO 37 C.F.R. § 1.193(b)

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. § 1.193(b), Appellant respectfully submits this Reply Brief in response to the Examiner's Answer dated March 25, 2004. Entry of this Reply Brief is respectfully requested.

POINTS RAISED IN EXAMINER'S ANSWER

The Examiner's Answer continues to base the grounds of rejection on conclusory statements that find no support in the applied art. For the reasons set forth in Appellant's Appeal Brief, the rejection of the claims on appeal should be reversed. In addition, Appellant submits the following remarks addressing certain points raised by the Examiner in his Answer.

The Examiner's rejection of the claims on appeal are based on a fundamental misunderstanding of what the prior art references actually disclose. Specifically, the Examiner

takes away from McGregor et al. alleged teachings that are not found anywhere in the disclosure, but that are taken from Appellant's disclosure using improper hindsight.

For example, contrary to the Examiner's position, McGregor et al. simply does not teach adding materials to only the inner layer of the sheath of the cable. Indeed, according to claim 1 of McGregor et al. a mixture of silica and chromium oxide is dispersed in **at least one** of the layers of the sheath, providing resistance to degradation of the insulation (sheath). The reasons for this structure is clearly explained at column 2, lines 12 to 33 of McGregor et al.: extending the life of *windings* (formed from a McGregor et al. cable) in a motor used in an inverter drive application.

McGregor et al. is completely silent about the values of tensile strength and elongation at break of the different layers of the cable sheath. That is also true for Wargotz et al.

Therefore, the Examiner's reasoning is based on Appellant's disclosure and not the applied references. The law is clear that such hindsight reconstruction is not permitted. *See, e.g., In re Fritch*, 23 USPQ2d 1780 (Fed. Cir. 1992); *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 10 USPQ2d 1397 (Fed. Cir. 1989); and *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988).

Furthermore, both McGregor et al. and Wargotz et al. are silent about any influence of additives to insulating materials in the direction of tensile strength and elongation at break. Therefore, it is also possible that the additives of McGregor et al. lead to exactly the *contrary* of the invention when added to the inner layer with an increase of the values of tensile strength and elongation at break. There also exists the possibility that nothing happens with these values upon adding the materials of McGregor et al. to the insulating material. The disclosure of McGregor

et al., being entirely silent on the subject of tensile strength and elongation at break of the various layers, simply provides no teaching either way.

Finally, the Examiner's combination of Wargotz et al. and McGregor et al. is based only on the fact that the two references relate to the very broad art of electrical cables. This basis underscores the Examiner's improper hindsight reconstruction, since the Examiner has failed to properly consider the teachings of each disclosure *as a whole*. See Manual Of Patenting Examining Procedure § 2141. This failure has led the Examiner to ignore the very different applications for the cables in each of the two references. That is, as explained in Appellant's Appeal Brief, Wargotz et al. describes an underground power and service entrance cable. McGregor et al., on the other hand, describes magnet wire insulation that can withstand voltage wave shapes present in inverter driven motors. See Appeal Brief at pages 7-9. The *different structures* disclosed in these patents are intended for very *different applications*. The proper consideration that one of ordinary skill in the art would have given has been ignored in the Examiner's grounds of rejection.

Appellant's Reply Brief
U.S. Application No. 09/915,528

Attorney Docket No.: Q63846

CONCLUSION

For the above reasons, as well as the reasons set forth in Appellant's Brief on Appeal, Appellant respectfully requests that the Board reverse the Examiner's rejections of all claims on Appeal. An early and favorable decision on the merits of this Appeal is respectfully requested.

Respectfully submitted,



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CUSTOMER NUMBER

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